

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Geoffrey R. Hill et al

Title: CHAPERONIN 10
IMMUNOSUPPRESSION

Appl. No.: 10/534,193

Filing Date: 12/7/2005

Patent No.: 7,618,935

Grant Date: November 17, 2009

Examiner: Schwadron, Ronald B.

Art Unit: 1644

Confirmation 9978
Number:

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent, which issued on November 17, 2009 as U.S. Patent No. 7,618,935.

The Patent Office determined that the patent was entitled to 351 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 879 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B): 964 days

(b) Total Applicant delay: 85 days

Final PTA Determination: 879 days

Applicants therefore respectfully request that the patent be accorded 879 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date 1/5/10

By Steph E. L.

FOLEY & LARDNER LLP
Customer Number: 30542
Telephone: (858) 847-6711
Facsimile: (858) 792-6773

Stephen E. Reiter
Attorney for Applicant
Registration No. 31,192

Patent Term Adjustment Calculation System

Docket Number: 026470-0501
 Application Number: 10/534193
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Priority Date	11/06/2002	-912		
Edit Delete	International Filing Date	11/06/2003	-547		
	PCT National Stage Commencement Date	05/06/2005	0		
Edit Delete	National Stage Entry (All 371(c) Requirements Met)	12/07/2005	215		
Edit Delete	Preliminary Amendment under 1.704(c)(6) Received at PTO	12/07/2005	215		
	14 month From Application date	02/07/2007	642		
Edit Delete	Non-Final Office Action	03/17/2008	1,046	404	
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	04/02/2008	1,062		
	3 Year Period Starts	05/06/2008	1,096		
	Non-Final Office Action + 3 months	06/17/2008	1,138		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	07/15/2008	1,166		28
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	07/15/2008	1,166		
Edit Delete	IDS NOT falling under 1.704(c)(6), (8) or (10) filed at PTO	10/31/2008	1,274		
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	11/15/2008	1,289		
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Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	05/05/2009	1,460		
Edit Delete	Notice of Allowance	06/24/2009	1,510		
Edit Delete	Issue Fee Paid	09/22/2009	1,600		
Edit Delete	IDS under 1.704(c)(10) filed at PTO	09/22/2009	1,600		
Edit Delete	Post-Allowance Document Received at PTO	09/24/2009	1,602		
Edit Delete	Patent Grant Date	11/17/2009	1,656	560	(57),(55) 57
Totals:				964	85
PTA:				879	

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